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Mail Stop APPEAL BRIEF- PATENTS Conf. No. 7941	U.S. Patent & Trademark Office Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	(571) 273-8300

FROM: John D. Titus, Reg. No. 39,047

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MESSAGE:

Please see attached Appellants' Reply Brief dated January 9, 2008, relating to
Application No. ~~10/706,841~~ filed November 10, 2003.
10/706,481

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Attorney Docket No.: KMC-570
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
: :
Richard R. Sanchez, et al. : Group Art Unit: 3711
: :
Serial No. 10/706,481 : Examiner: Alvin A. Hunter
: :
Filed: November 10, 2003 : Conf. No. 7941
Title: GOLF CLUB WITH SWING BALANCE WEIGHT COVER

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed 11/19/2007 and the second copy of the Examiner's Answer subsequently mailed 12/14/2007, and pursuant to 37 CFR § 41.41, Appellants submit the following reply:

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Appellants' Reply Brief

REPLY

Appellants and the Examiner appear to agree that the essence of this appeal is whether or not the weights disclosed in Wahl et al. move or do not move. If the weights in Wahl et al. (the primary reference relied on by the Examiner) are rigidly mounted, then Appellants agree that the Examiner should be sustained. If, however, the weights disclosed in Wahl et al. move, then the Examiner should be reversed.

The Examiner's insistence in his answering brief that the weights in Wahl et al. do not move flies in the face of elementary principals of dynamics and vibration analysis. The Examiner states that "The weight within the cavity of Wahl et al. does not move." However, the Examiner goes on to state that "the friction is created by the compression of the sleeve." Appellants query: How can the sleeve be compressed if it is not the weight within the sleeve moving to compress it? Wahl et al. answers this very question in the statement at column 2 lines 54-62 (previously cited by Appellants and ignored by the Examiner) that the "vibrations are dissipated by compression of the intermediate layer [sleeve] and friction between the core [weight] and the intermediate layer [sleeve]. Clearly, for there to be compression and friction between the weight and sleeve, as stated in Wahl, et al., the weight must move within the sleeve. Therefore it cannot be rigidly mounted as maintained by the Examiner.

The Examiners' argument that if the weights moved they would necessarily smack the cover is frivolous. For the sleeves to be compressed as stated in Wahl, et al., the weights would obviously move laterally, not axially and therefore would not necessarily impact the cover. Additionally, even if the weights moved axially with sufficient amplitude to strike the cover,

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there is simply no evidence to support the Examiner's speculation that a tungsten core striking a plastic cover would be heard over the sound of the iron club striking the ball.

The Examiner apparently fails to comprehend the problem solved by Appellants' invention and how it differs from the problem solved by Wahl, et al. Appellants' invention is directed to solving an inventory problem, not a vibration or center of gravity problem. These problems and their solutions are well known in the art. The Examiner also misstates that the invention of Wahl et al. is directed to weighting the club head to lower the center of gravity of the club head. Wahl et al. notes in the *background of the invention* that weighting the club head to lower the center of gravity is well known in the art. Therefore this cannot be the invention disclosed in Wahl et al. Indeed, the invention of Wahl, et al. is directed to solving the problem of club head vibrations caused by the prior art weighting to lower the center of gravity. The solution proposed by Wahl, et al. was to mount several weights in elastomeric sleeves inside the head so that the head vibrations would be dissipated by viscous damping caused by the weights compressing the elastomeric sleeves and by coulomb friction caused by the weights sliding within the sleeve. Both of these actions require the weight to move, because without movement of the weight there would be no energy dissipated and no vibration damping.

Finally, the Examiner ends with the fallacious argument that Appellants' weights are not rigidly mounted because nothing in the world is perfectly rigid. According to the Examiner, for something to be rigidly mounted it would have to be integrally formed. Not only does this argument do violence to the meaning of "rigidly mounted" among those skilled in the art and as defined in the specification, but it reveals the inconsistency in the positions taken by the

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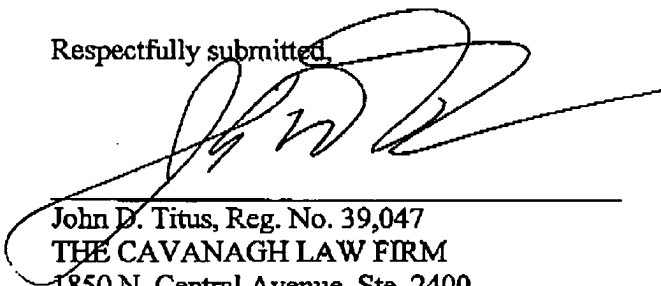
Appellants' Reply Brief

Examiner. If the swing weights of Appellants' invention, which are mounted *e.g.* with threaded fasteners are not rigidly mounted in the eyes of the Examiner, how can the Examiner take the position that the weights of Wahl et al. which are held in elastomeric sleeves *are* rigidly mounted?

CONCLUSION

For the reasons stated above and in Appellants' Brief in Support of Appeal, the weights in Wahl et al. must move in order to damp the club head vibrations. Consequently, the Examiner's proposed combinations, all of which rely on Wahl et al. as the primary reference, cannot make obvious the claims of the present application in which the weights are rigidly mounted, because such a combination would render Wahl et al. unsuitable for its intended purpose, since a rigidly mounted weight would not damp the club head vibrations.

Respectfully submitted,

Dated: 9 Jan 2008

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Rosalind E. Smith

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